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09/609,891	07/05/2000	Joseph W. Luciano	LE9-00-044	5238

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LEXMARK INTERNATIONAL, INC.  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
740 WEST NEW CIRCLE ROAD  
BLDG. 082-1  
LEXINGTON, KY 40550-0999

EXAMINER

GARCIA, GABRIEL I

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/609,891

Applicant(s)  
Luciano

Examiner  
G. Garcia

Art Unit  
2624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 19, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

Part III DETAILED ACTION

1. This application has been examined. Claims 1-23 are pending in this application.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1,2 and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Stephenson (5,949,469).

With regard to claim 1, Stephenson teaches a photoprinter configuration (see figures 1-3) comprising: a digital camera (10) comprising a viewable display (18) and one or more selection mechanisms (20,22 or 14); and a photoprinter (12) capable of processing and printing digital files independent of an external host device (reads on figs. 1-3, which depicts how the camera and printer interact independent of an external device) and connected

to the digital camera via a communication link (see col. 4, lines 20-23), the photoprnter being operative to control the viewable display of the digital camera (see col. 4, lines 20-65).

With regard to claim 2, Stephenson teaches the photoprinter is further operative to direct a result from a user's input to the selection mechanisms (see col. 4).

With regard to claim 6, Stephenson further comprising a means for controlling the digital camera by the photoprinter (see col. 4).

With regard to method claims 7-12, the limitations of claims 7-12 are taught by the means of claims 1,2 and 6 that provide the functions steps claimed in claims 7-12.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson (5,949,469) as applied to claim 1 above.

With regard to claim 3, Stephenson teaches using a communication link between the camera and the printer (see details in claim 1 above), but fails to teach that the communication link is a universal serial bus). Examiner takes official notice (MPEP 2144.03) that it is well known in the art of photo printing to use a universal serial bus between a photoprinter and a digital camera. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system as taught by Stephenson with a universal serial bus because of the following reasons: a) in order to standardize the system as taught by Stephenson, to comply with industry standards; and b) by using industry standards allows the system to be used with different compatible devices.

With regard to claim 5, Stephenson teaches fails to explicitly teach using an open operating system. Examiner takes official notice (MPEP 2144.03) that it is well known in the art of digital cameras to use an open operating system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the camera as taught by Stephenson with an open operating system because of the following reasons: a) in order to standardize the system to control the different hardware and software resources; and b) in order to manage the digital camera more efficiently using an operating system such as windows NT or unix).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson (5,949,469) as applied to claim 1 above, and further in view of Hanada (6,000,864).

With regard to claim 4, Stephenson teaches using a communication link between the camera and the printer (see details in claim 1 above), but fails to teach using a wireless communication link. Hanada teaches that it is well known in the art to transmit data between a digital camera and a printer using wireless means (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the apparatus of Stephenson with means to transmit data wirelessly, in order to send information between the camera and the printer without using wires, reducing the complication of making the connections between the camera and the printer, and in order to send information between the camera and the printer when both are located in relatively different remote locations.

7. Claims 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson (5,949,469) as applied to claims 1-6 above, and further in view of Taniguchi et al. (5,999,707).

With regard to claims 13-20, the limitations of claims 13-20 are covered by the limitations of claims 1-6 above and Stephenson fails teach the printer as being operable as a client to a host

computer. Taniguchi et al. teaches that it is well known in the art to make a printer operate as a client to a host computer (see abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system as taught by Stephenson with a host and allowing the printer to operate as a host to the printer because of the following reasons: a) in order to allow the printer of Stephenson to select information from the host as to operate the digital camera and to control information between the camera and the host computer; and b) in order to allow the printer of Stephenson to be an intelligent printer that allows the manipulation of the camera and the receiving of information from the host.

With regard to claims 21-23, the limitations of claims 21-23 are covered by the limitations of claims 1-6 and 13 above.

#### ***Conclusion***

8. Applicant's arguments filed 12/19/01 have been fully considered but they are not persuasive.

With regard to Applicant's argument that Stephenson does not teach or suggest printer configuration and methods for controlling a digital camera.

Examiner asserts that Stephenson does teach or suggest printer configuration and methods for controlling a digital camera (e.g. figs. 1-3 and col. 4, lines 21-33). Col. 4, lines 21-25 clearly describes how the printer (12) controls the camera (10).

With regard to Applicant's argument that Stephenson does not teach or suggest a configuration is not a photoprinter.

Examiner asserts that Stephenson does teach a configuration is a photoprinter (e.g. figs. 1-3, clearly describe a camera connected to a printer, that prints photos).

With regard to Applicant's argument that Stephenson does not teach or suggest printing digital files independent of an external host device.

Examiner asserts that Stephenson does teach printing digital files independent of an external host device (reads on figs. 1-3, which depicts how the camera and printer interact independent of an external device).

With regard to Applicant's argument that Stephenson does not teach or suggest a stand alone printer.

Examiner asserts that Stephenson does teach a stand alone printer (reads on fig. 2).

In response to applicant's arguments against the Stepheson individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208



USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday thru Thursday from 7:30AM-6:00PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314 (official or unofficial)

Gabriel I. Garcia  
Primary Examiner  
April 20, 2002

  
GABRIEL GARCIA  
PRIMARY EXAMINER